TTAB

IN THE UNITED PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CENTRAL MFG. CO.
(a Delaware Corporation)
P.O. Box 35189
Chicago, IL 60707-0189

Opposer,

vs.

PARAMOUNT PARKS, INC.
8720 Red Oak Blvd.
Charlotte, NC 28217

Applicant

Box TTAB/NO FEE

Opposition No: 91123765

Trademark: HYPERSONIC

[redacted]

04-12-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

MOTION TO COMPEL

NOW COMES the Opposers and requests the Board to compel the attendance of the following three witnesses for discovery depositions[1]: **Mel Karmazin, Sumner M. Redstone and Richard J. Bressler.** These three deponents are employees of the parent company of the Applicant, Paramount Parks. The Opposer noticed the said depositions on April 2, 2004. See attached notices of deposition and correspondence to Applicant's counsel, marked as **Group Exhibit A**.

Applicant's counsel responded with its Objection to Notices of Deposition, dated April 2, 2004. See attached true and correct copy of said motion, marked as **Exhibit B**.

Opposer made a good faith effort to resolve the discovery dispute with a telephone conversation on April 5, 2004, with Applicant's counsel, Mr. Lance Koonce. Mr. Koonce responded with a letter dated April 5, 2004, attached hereto and marked as **Exhibit C**, confirming the he will not produce the said deponents.

---

1. The Opposer served its notices of deposition on the Applicant by fax and regular mail. The Applicant interprets the Board Order of March 9, 2004, which required the parties to serve each other by Express Mailing. The Opposer interpreted this provision to mean that any documents served with the Board, should be served by the parties on each other by Express Mailing. In any event, the Applicant has timely received Opposer's said notices of deposition and has made its appropriate objections. For the record, the Opposer will re-serve the said notices via Express Mail with this pleading on the Applicant in order to avoid any appearance of the Opposer not complying with the Express Mailing requirement initiated by the Board in the Board's March 9, 2004 order.

The Opposer asserts that upon information and belief, the said deponents are necessary for Opposer to prove its case, as they have and/or should have knowledge of Paramount Parks' current trademark application. In addition, the Applicant has consistently communicated with Mallory D. Levitt, an employee of Viacom. It is the position of the Opposer that the Applicant was not the party that owned the mark at the time the said application was filed. The Opposer asserted in its motion for summary judgment that Applicant's failure to disclose its relationship with Viacom "is fatal to its application." The Board, in its decision of March 9, 2004, stated that " ... Opposer has not met its burden of establishing that no genuine issue of material fact exists as to any of the grounds on which it bases its motion for summary judgment." The Board stated at page 6 in a footnote, "We note that opposer's grounds for its summary judgment motion that applicant is not the owner of the involved mark and that applicant has failed to disclose the nature of its relationship with Viacom, Inc., as well as all of opposer's grounds related to applicant's use of the mark are unpleaded and that applicant has objected on that basis. See TBMP Section 528.07. Accordingly, opposer may not obtain summary judgment on any of those grounds." The Opposer has filed with this pleading an Amended Notice of Opposition, curing the Applicant's objection to Opposer's grounds that relate to the nature of Applicant's relationship with Viacom, and all of Opposer's grounds related to Applicant's use of the mark. Consequently, the Opposer should be entitled to having the Board compel the said deponents to appear at their discovery depositions.

WHEREFORE, the Opposer prays that the Board grant its Motion to Compel.

By: Leo Stoller

Leo Stoller
CENTRAL MFG. CO., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773-283-3880 FAX 708 453-0083

Date: April 8, 2004

Certificate of Service

I hereby certify that this *Motion to Compel* is being deposited with the U.S. Postal Service by **Express Mail No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce
Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

Leo Stoller
Date: April 8, 2004

Certificate of Mailing

I hereby certify that the foregoing *Motion to Compel* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513

Leo Stoller
Date: April 8, 2004

D:\MARKS32\PARAM.DEP

** Fax Report **

Date	:	Apr 02,04 12:39
Location	:	12124898340
Pages	:	07
Result	:	OK

EXHIBIT A

HYPERSONIC

HYPERSONIC BRAND PRODUCTS AND SERVICES *SINCE 1981*
Post Office Box 35189
Chicago, Illinois 60707-0189
VOICE 773/283-3880 * FAX 708/453-0083 * WEB PAGE: www.rentamark.com

VIA FAX & MAIL

Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

Re: **Central Mfg. Co. v. Paramount Parks, Inc., Opp. No. 91123765**
Notices of Deposition

Dear Mr. Koonce:

I will agree to an amendment of the standard protective order which includes the following provision:

"Persons obtaining access to stamped confidential documents under this order shall use the information only for preparation and trial of the instant TTAB proceeding, Opposition No. 91123765 (including appeals and retrials), and shall not use such information for any other purpose, including business, governmental, commercial, administrative, or judicial proceedings."

I received your Notice of Deposition scheduled for April 20, 2004, to take place in Chicago. I am not available on that date and I would suggest that the deposition be taken on April 21, 2004 in your offices, commencing at 8:00 a.m., New York time. I am also noticing the depositions of Mel Karmazin, Sumner M. Redstone and Richard J. Bressler. This way, we can take care of all the depositions on April 21, 2004, in your offices.

Please advise by return fax if the Applicant will produce its witnesses pursuant to Opposer's notices for April 21, 2004.

Most Cordially,

Leo Stoller, President

D:\MARKS32\PARAM.LTR

IN THE UNITED PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CENTRAL MFG. CO.
(a Delaware Corporation)
P O Box 35189
Chicago, IL 60707-0189

Opposer,

vs.

PARAMOUNT PARKS, INC.
8720 Red Oak Blvd.
Charlotte, NC 28217

Applicant

Opposition No: 123,765

Trademark: HYPERSONIC

/

Box TTAB/NO FEE

04-12-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

NOTICE OF DEPOSITION

Please take Notice that Opposer will take the deposition upon oral examination, of the President of VIACOM, INC., **Mel Karmazin**, before a Notary Public or other office authorized by law to administer oaths. The deposition will be held at the offices of *Davis Wright Tremaine, LLP, 1633 Broadway, New York, New York, 10019* on **April 21, 2004** commencing at **11:00 a.m.**, or such other date, time and place as mutually agreed upon by counsel. The testimony will be stenographically recorded. You are invited to attend and cross-examine.

By: Leo Stoller

Leo Stoller
CENTRAL MFG. CO., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773-283-3880 FAX 708 453-0083

Date: April 2, 2004

Certificate of Service

I hereby certify that this *Notice of Deposition* is being deposited with the U.S. Postal Service by first class mail in an envelope addressed to:

Leo Stoller
Date: April 2, 2004

Certificate of Mailing

I hereby certify that the foregoing *Notice of Deposition* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513

Leo Stoller
Date: _____

D:\MARKS32\PARAM.DEP

IN THE UNITED PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CENTRAL MFG. CO.
(a Delaware Corporation)
P O Box 35189
Chicago, IL 60707-0189

Opposition No: 123,765

Opposer,

Trademark: HYPERSONIC

vs.

PARAMOUNT PARKS, INC.
8720 Red Oak Blvd.
Charlotte, NC 28217

Applicant

/
Box TTAB/NO FEE

NOTICE OF DEPOSITION

Please take Notice that Opposer will take the deposition upon oral examination, of the Chairman of VIACOM, INC., **Sumner M. Redstone**, before a Notary Public or other office authorized by law to administer oaths. The deposition will be held at the offices of *Davis Wright Tremaine, LLP, 1633 Broadway, New York, New York, 10019* on **April 21, 2004** commencing at **2:00 p.m.**, or such other date, time and place as mutually agreed upon by counsel. The testimony will be stenographically recorded. You are invited to attend and cross-examine.

By: Leo Stoller

Leo Stoller
CENTRAL MFG. CO., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773-283-3880 FAX 708 453-0083

Date: April 2, 2004

Certificate of Service

I hereby certify that this *Notice of Deposition* is being deposited with the U.S. Postal Service by first class mail in an envelope addressed to:

Leo Stoller
Date: April 2, 2004

Certificate of Service

I hereby certify that this *Notice of Deposition* is being deposited with the U.S. Postal Service by **Express Mail No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce
Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

Leo Stoller
Date: April 8, 2004

Certificate of Mailing

I hereby certify that the foregoing *Notice of Deposition* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513

Leo Stoller
Date: 4-8-04

D:\MARKS32\PARAM.DEP

IN THE UNITED PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CENTRAL MFG. CO.
(a Delaware Corporation)
P O Box 35189
Chicago, IL 60707-0189

Opposer,

vs.

PARAMOUNT PARKS, INC.
8720 Red Oak Blvd.
Charlotte, NC 28217

Applicant

Opposition No: 123,765

Trademark: HYPERSONIC

/
Box TTAB/NO FEE

NOTICE OF DEPOSITION

Please take Notice that Opposer will take the deposition upon oral examination, of the Chief Financial Officer of VIACOM, INC., **Richard J. Bressler**, before a Notary Public or other office authorized by law to administer oaths. The deposition will be held at the offices of *Davis Wright Tremaine, LLP, 1633 Broadway, New York, New York, 10019* on **April 21, 2004** commencing at **4:00 p.m.**, or such other date, time and place as mutually agreed upon by counsel. The testimony will be stenographically recorded. You are invited to attend and cross-examine.

By: Leo Stoller

Leo Stoller
CENTRAL MFG. CO., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773-283-3880 FAX 708 453-0083

Date: April 2, 2004

Certificate of Service

I hereby certify that this *Notice of Deposition* is being deposited with the U.S. Postal Service by first class mail in an envelope addressed to:

_____
Leo Stoller
Date: April 2, 2004

Certificate of Service

I hereby certify that this *Notice of Deposition* is being deposited with the U.S. Postal Service by **Express Mail No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce
Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

_____
Leo Stoller
Date: April 8, 2004

Certificate of Mailing

I hereby certify that the foregoing *Notice of Deposition* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513

_____
Leo Stoller
Date: 04-8-04

D:\MARKS32\PARAM.DEP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter of Application Serial Nos. 76/103,447 and 76/103448
Published In The Official Gazette of May 22, 2001
and April 24, 2001, Respectively

Mark: HYPERSONIC

Central Mfg. Co.,	:	
Opposer,	:	**Opposition No. 123,765**
-against-	:	
Paramount Parks Inc.,	:	
Applicant.	:	

OBJECTIONS TO NOTICES OF DEPOSITION

Applicant Paramount Parks, Inc., by its undersigned attorneys, objects to the Notices of Deposition of Mel Karmazin, Sumner Redstone and Richard Bressler, each dated April 2, 2004 and propounded by Opposer Central Mfg. Co. (collectively, the "Notices"), as follows:

1. The Notices were improperly served, as they were not served by Express Mail as required by the Order of the Trademark Trial and Appeal Board dated March 9, 2004.
2. The individuals noticed are not employees of Applicant.
3. The individuals noticed do not have knowledge relevant to the claim or defense of any party in this proceeding, and the depositions

EXHIBIT B

noticed by Opposer are not reasonably calculated to lead to the discovery of admissible evidence, but propounded solely for tactical advantage.

Dated: New York, New York
April 2, 2004

DAVIS WRIGHT TREMAINE LLP

By: _____
Lacy H. Koonce, III (LHK-8784)
1633 Broadway
New York, New York 10019
(212) 603-6467

Attorneys for Applicant Paramount Parks, Inc.

TO:

Leo Stoller
Central Manufacturing Co.
P.O. Box 35189
Chicago, IL 60707-0189

AFFIDAVIT OF SERVICE

STATE OF NEW YORK)
: ss.:
COUNTY OF NEW YORK)

I, LORETTA E. PERRY, being sworn, say: I am not a party to the action, am over 18 years of age and reside in Kings County.

On April 2, 2004 I served the within OBJECTIONS TO NOTICES OF DEPOSITION by depositing a true and complete copy of same enclosed in a pre-paid United States Postal Service Express Mail Next Day Delivery Service wrapper in an official depository under the exclusive care and custody of the U.S. Postal Service within New York State, addressed to:

Leo Stoller
Hypersonic Brand Products and Services
And Central Manufacturing Co.
P.O. Box 35189
Chicago, IL 60707-0189

LORETTA E. PERRY

Sworn to before me this
2ND day of April, 2004

Notary Public

LACY H. KOONCE III
NOTARY PUBLIC, State of New York
No. 02KO6029665
Qualified in New York County
Commission Expires August 23, 2005

NYC 143903v1 53212-6

LAWYERS

Davis Wright Tremaine LLP

ANCHORAGE BELLEVUE LOS ANGELES NEW YORK PORTLAND SAN FRANCISCO SEATTLE SHANGHAI WASHINGTON, D.C.

Lance Koonce
Direct Dial: (212) 603-6467
lancekoonce@dwt.com

1633 BROADWAY
NEW YORK, NY 10019-6708

TEL (212) 489-8230
FAX (212) 489-8340
www.dwt.com

April 5, 2004

VIA EXPRESS MAIL

Mr. Leo Stoller
Hypersonic Brand Products and Services
and Central Manufacturing Co.
P.O. Box 35189
Chicago, IL 60707-0189

Re: Central Mfg. Co. v. Paramount Parks Inc.,
Trademark Trial and Appeal Board Opposition No. 91123765

Dear Mr. Stoller:

This is to confirm the substance of our telephone conversation this afternoon. We have agreed that you will make available to us for inspection and copying those of Opposer's documents that are responsive to Applicant's document requests on Wednesday, April 14, 2004 at your offices in Chicago. I plan to arrive no later than 10:00 a.m. to inspect those documents.

You have agreed to endeavor to produce a copy set of relevant documents to us in New York on or before April 13, 2004, in light of the fact that, as a courtesy, we earlier produced documents responsive to Opposer's requests to you in Chicago. If you indeed produce documents to us on or before April 13, and if that production appears sufficiently responsive to Applicant's requests, we may cancel our trip to Chicago to review documents on-site. However, nothing herein shall constitute a waiver of Applicant's right to inspect and copy documents on-site should any production by Opposer be incomplete or otherwise insufficient.

You stated in our telephone conversation that in light of Applicant's objections to the depositions of Sumner Redstone, Mel Karmazin and Richard Bressler, you will not travel to New York for your deposition. Instead, the parties have agreed that Applicant will take your deposition on April 20, 2004 in Chicago, at the location originally specified in the Notice of Deposition served recently on Opposer (the offices of Joseph, Lichtenstein & Levinson, 134

EXHIBIT C

North LaSalle Street, Chicago, Illinois 60602). We agree to begin the deposition at 10:00 a.m., per your request.

Very Truly Yours,

Lance Koonce

LK/lp
Mallory D. Levitt, Esq.

IN THE UNITED PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CENTRAL MFG. CO.
(a Delaware Corporation)
P O Box 35189
Chicago, IL 60707-0189

Opposer,

vs.

PARAMOUNT PARKS, INC.
8720 Red Oak Blvd.
Charlotte, NC 28217

Applicant

Opposition No: 91123765

Trademark: HYPERSONIC

04-12-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

/
Box TTAB/NO FEE

MOTION TO AMEND NOTICE OF OPPOSITION

NOW COMES the Opposer and requests leave to file its Amended Notice of Opposition because justice so requires. See 37 CFR §§2.107, 2.115, and 2.11(a).

The Opposer states that the Applicant would not be prejudiced by the allowing of the proposed amendment in view of the fact that discovery is still open. See generally, *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had as yet taken testimony); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975) (since proceeding was still in the pre-trial stage, amendment of the pleadings could not prejudice opposer); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) (since, inter alia, the trial period had not yet commenced, no prejudice to applicant); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974) (applicant would not be unduly prejudiced by entry of the proposed amendment since no testimony had as yet been taken).

WHEREFORE, the Opposer prays that the Board grant its Motion to Amend its Notice of Opposition which is attached hereto and made a part hereof.

By: Leo Stoller

Leo Stoller
CENTRAL MFG. CO., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773-283-3880 FAX 708 453-0083

Date: April 8, 2004

Certificate of Service

I hereby certify that this *Motion to Amend* is being deposited with the U.S. Postal Service by **Express Mail No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce
Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

Leo Stoller
Date: April 8, 2004

Certificate of Mailing

I hereby certify that the foregoing *Motion to Amend* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513

Leo Stoller
Date: April 8, 2004

D:\MARKS32\PARAMT.MOT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CENTRAL MFG. CO. P.O. Box 35189 Chicago, IL 60707-0189	Opposition	91123765
	Trademark:	HYPERSONIC
Opposer, vs.	Application SN:	76-103,447 and 76,103,448
PARAMOUNT PARKS, INC. (a division of Viacom International Inc.) 8720 Red Oak Boulevard Charlotte, NC 28217	Int. Class No:	25 and 16
	Published:	May 22, 2001 and
Applicant.		April 24, 2001

/

TTAB/NO FEE
IN TRIPLICATE

HYPERSONIC vs. HYPERSONIC

AMENDED NOTICE OF OPPOSITION

1. In the matter of Intent to Use Application SN 76-103,447 for the mark HYPERSONIC, Int. Class 25, for **t-shirts, sweatshirts, hats, jackets, pajamas, masquerade costumes, tank tops, footwear, sweatpants and shorts**, and SN 76-103,448, for the mark HYPERSONIC, Int. Class 16 for **paper goods and printed matter, namely calendars, fiction magazines, comic books, greeting cards, posters, a series of fiction books, trading cards, stickers, notepads, notebooks, postcards, gift wrapping, bumper stickers, rubber stamps.**

2. The Opposer, CENTRAL MFG. CO a Delaware Corporation, and/or its predecessor in title, has priority of use of the mark *HYPERSONIC,* in Common Law on similar goods, related goods, and competitive goods; namely, t-shirts, hats, footwear, jackets, postcards, notebooks, bumper stickers, and rubber stamps, sold in similar channels of trade and to the identical customers that applicant's goods are sold in, since at least as early as 1988.

3. The Opposer, has priority of use of the mark *HYPERSONIC* in numerous classes of goods and services including Int. Cl. No. 28 on similar goods as the Applicant, on closely related goods that are listed in Applicant's attached copy of its Registration No: 1,593,157 which it relies upon in support of this Opposition, which are sold in the same channels of trade and to similar

customers as Applicant's since at least as early as 1988 and hereby opposes registration of the confusingly similar mark, Application Serial No. 76-103,447 and 76-103,448. Opposer asserts that there is a likelihood of confusion between the Applicant's mark HYPERSONIC and the Opposer's registered *HYPERSONIC* mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

4. The Opposer, CENTRAL MFG., (hereinafter referred to as *HYPERSONIC*), like the McDonald's Corporation uses its well-known *HYPERSONIC* mark as a trade name, corporate name, service mark and trademark since at least as early as 1988 and is engaged in an aggressive *HYPERSONIC* licensing and marketing program. The Opposer holds rights, in the following *HYPERSONIC* trademark registrations (attached herewith).

5. The Opposer, hereinafter referred to as ("*HYPERSONIC*"), located in Chicago, Illinois, who believes that it will be damaged by registration of the mark HYPERSONIC shown in Application SN 76-103,447 and 76-103,448 and hereby opposes same. *HYPERSONIC*, like the McDonald's Corporation, uses its *HYPERSONIC* mark as a trade name, corporate name, service mark and trademark and engages in an aggressive licensing program [1].

6. *HYPERSONIC* has used the trademark and trade name *HYPERSONIC* in interstate commerce, as a predecessor-in-interest, since at least as early as 1988, long prior to Applicant's submission of its Application for Federal Registration of the mark HYPERSONIC.

---

1. Licensing broadens the scope and strength of the legal protection of the corporate trademark. A typical trademark is normally used in a limited number of product classifications. This can sometimes encourage other companies to attempt to take unfair advantage of the value of that trademark by using that particular mark on a product in another class of goods. Licensing into other categories effectively preempts that type of undesirable adoption of the corporate trademark. In the event litigation takes place, it also establishes stronger ownership through broader use of the mark. Moreover, it's a very effective legal strategy in that it can effectively discourage infringement rather than requiring a reaction to it after the fact. There, licensing assures a more extensive recognition of the company's ownership of trademarks and copyrights through the additional uses. *The Benefits of a Corporate Licensing Program* by Glen Konkle, Esq., The Merchandising Reporter, April 1986.

7. The Opposer holds rights [1], in the following well-known *HYPERSONIC* trademark Registration No: 1,593,157, which is incorporated herein and attached and notice is hereby given that Opposer relies upon this *HYPERSONIC* Registration.

8. The Opposer has priority of use, as early as 1988, on similar, related and competitive goods.

9. The use of the Applicant's mark HYPERSONIC sought to be registered in the aforesaid application is likely to blur the distinctiveness of the Opposer's famous *HYPERSONIC* trademarks and cause dilution of Opposer famous mark.

10. The use of the Applicant's mark HYPERSONIC sought to be registered in the aforesaid application is likely to cause confusion, mistake or deception in the buying public or cause the public to believe that there is a connection between the parties, or a sponsorship of Applicant's goods by Opposer.

11. *HYPERSONIC* has used the designation *HYPERSONIC* as a corporate and trade name to identify its business continuously since long prior to Applicant's submission of its Application for registration to use the mark *HYPERSONIC* and has an aggressive licensing program for its valuable *HYPERSONIC* mark as well known to the Applicant, creating a national BRAND name.

12. In the U.S.A., the Opposer, as well known to the Applicant, licensees its famous *HYPERSONIC* mark for a wide variety of collateral merchandise. Opposer's mark became famous in 1990.

13. Opposer, as well known to the Applicant, expends substantial sums of money on

---

1. **§16.13 McCARTHY ON TRADEMARKS, II. Ownership. Who Is Owner Of Trademark, [1] Introduction,** Trademarks have often been held to be a kind of "property." In discussing "ownership of a trademark, we must recognize that we are dealing with intangible, intellectual property. "Ownership" means that one possesses a right which will be recognized and upheld in the courts: To say one has a "trademark" implies ownership and ownership implies the right to exclude others. If the law will not protect one's claim of right to exclude others from using an alleged trademark, then he does not own a "trademark", for that which all are free to use cannot be a trademark. Application of Deister Concentrator Co., 48 CCPA 952, 289 F.2d 496, 129 USPQ 314 (1961). Trademark ownership inures to the legal entity who is in fact using the mark as a symbol of origin. The Federal Trademark Register can be rectified in order to correct the ownership of a registered mark or a pending application. Chapman v. Mill Valley Cotton, 17 USPQ2d 1414 (TTAB 1990) (Opposer Alpha alleged that she, not applicant, owned the mark. Applicant was a joint venture composed of parties Alpha and Beta. After some litigation in state court, the parties filed an assignment from party Beta to party Alpha amounting to a concession that Alpha was indeed the owner of the mark. The Board viewed the TLRA 1989 amended version of §18, which permits rectifying the "register" as broad enough to include changing the name of the owner of an application, as well as of an issued registration.

policing the use of its popular and/or famous trademark see attach true and correct copy of HYPERSONIC and HYPERSONIC formative applications and trademarks that the Opposer has successfully opposed.

14. Since at least as early as 1981, *HYPERSONIC* has been, and *HYPERSONIC* is now, using the mark *HYPERSONIC* in connection with the sale of goods and/or services in numerous classes. Said use has been valid and continuous since said date of first use and has **not** been abandoned.

15. If the Applicant is permitted to register the mark that Opposer is opposing, and thereby, the *prima facie* exclusive right to use in commerce the mark HYPERSONIC on the goods licensed and sold by the Opposer, confusion is likely to result from any concurrent use of Opposer's mark *HYPERSONIC* and that of the Applicant's alleged mark HYPERSONIC all to the great detriment of Opposer, who has expended considerable sums and effort in promoting its mark.

16. Purchasers are likely to consider the goods of the Applicant sold under the mark HYPERSONIC as emanating from *HYPERSONIC*, and purchase such products as those of the Opposer, resulting in loss of sales to Opposer.

17. Said applications were obtained fraudulently in that the formal application papers filed by Applicant, under notice of §1001 of Title 18 of the United States Code stated that Applicant had a valid intent to use. Said statement was false. Said false statement was made with the knowledge and belief that it was false, with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration.

18. Said applications were obtained fraudulently in that the formal application papers filed by Applicant, under notice of §1001 of Title 18 of the United States Code stated that Applicant had a valid intent to use when Applicant filed its Trademark applications on August 2, 2000. Said statement was false. Applicant does not qualify for a valid Intent to Use application in that Applicant's applications do not qualify because Applicant's right to use in commerce must exist before a trademark may be registered. Applicant has no valid intent to use its mark in commerce and has no right to register the mark.

19. Said applications were obtained fraudulently in that the formal application papers filed by Applicant, under notice of §1(b), 15 U.S.C. §1051(b) of the United States Code, Applicant must assert a bona fide intent to use the mark in commerce, on or in connection with the goods identified. Applicant's said assertion of a bona fide intent to use the mark in commerce was false. Applicant *never* had a valid intent to use its trademark in *commerce.* Thus, Applicant said's applications are void *ab initio* stated that Applicant had a valid intent to use when Applicant filed its Trademark applications on August 2, 2000,. as well known to **Mallory Levitt**, Esq., in house counsel for Viacom and Paramount, and to **Lance Koonce** Esq., and **Marcia B. Paul**, Esq., of Applicant's law firm of Kay, Collyer & Boose, LLP, in violation of 37 CFR §10.23(a)(4).

a. Applicant's said counsel upon information and belief conspired to defraud the PTO by filing and maintaining the said trademark applications wherein it was well known to **Mallory Levitt**, Esq., in house counsel for Viacom and Paramount, and to **Lance Koonce** Esq., and **Marcia B. Paul** , that the applicant had no valid intent to use application because the applicant had no valid intent to use the said marks in commerce in violation of 37 CFR §10.23(a)(4).

b. Upon information and belief **Mallory Levitt**, Esq., in house counsel for Viacom/Paramount, and counsel for the applicant **Lance Koonce** Esq., and **Marcia B. Paul** knew or should have known that, Paramount/Viacom had been using the said mark on some or all of the goods listed in the said Applicant's prior to Applicant filing its *intent to use* Application, in violation of 37 CFR §10.23(a)(4).

20. Applicant had been using the mark listed in Application SN: 76,103,448 prior to filing its *intent to use* application on August 2, 2000, on the goods listed in its said application.

21. Said applications were obtained fraudulently in that the formal application papers filed by Applicant, under notice of §1001 of Title 18 of the United States Code stated that Applicant had a valid intent to use when Applicant filed its Trademark applications on August 2, 2000. Said statement was false

22. Said applications were obtained fraudulently in that the formal application papers filed by Applicant, under notice of §1001 of Title 18 of the United States Code stated that Applicant had a valid intent to use when Applicant filed its Trademark application on December 7, 1998. Said statement was false. Applicant had been using the said mark on all or some of the goods

listed in its applications long prior to the filing of its applications on August 2, 2000. Applicant's intent to use applications were a fraud in that Applicant had use on some or all of the said goods listed therein bearing the mark HYPERSONIC long prior to the filing date of August 2, 2000. Said intent to use statement was a false statement and was made with the knowledge and belief that it was false, with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration.

23. At the time the Applicant filed the said application, it was not the owner of the mark.

24. Applicant failed to disclose its relationship with Viacom International, Inc. at the time it filed its said trademark application which was fatal to Applicant's said application.

25. Concurrent use of the mark HYPERSONIC by the Applicant and *HYPERSONIC* by the Opposer may result in irreparable damage to Opposer's national HYPERSONIC BRAND, its Trademark Licensing Program, its marketing program, reputation and goodwill.

26. Applicant's use of the HYPERSONIC mark as its company name, trade name and trademark is an obvious attempt by the Applicant to trade off the goodwill of the Opposer's mark *HYPERSONIC*, which the Opposer has built up for over 20 years, in direct violation of the Lanham Act. The Board should deny Applicant registration of its confusingly similar mark.

27. If the Applicant is permitted to obtain a registration of the mark STEALTH, a cloud will be placed on Opposer's title in and to its trademark, *HYPERSONIC*, and on its right to enjoy the free and exclusive use thereof in connection with the sale of its services and/or goods, and on its Trademark Licensing Program, all to the great injury of the Opposer.

28. Upon information and belief, Applicant's Intent to Use Application were signed with the knowledge that another party had a right to use the mark in commerce.

29. The registration to Applicant of the mark HYPERSONIC shown in the aforesaid applications are likely to and will result in financial and other injury and damage to *HYPERSONIC* in its business and in its enjoyment of its established rights in and to its said mark *HYPERSONIC* and damage Opposer's famous family of *HYPERSONIC* marks promoted and licensed in concert.

30. Applicant's mark HYPERSONIC, when used on or in connection with the goods of the Applicant, are merely descriptive or deceptively misdescriptive of the goods.

31. Applicant's mark HYPERSONIC, as used on the goods defined in its applications, or, intended to be used, is not a substantially exact representation of the mark intended to be used in connection with the goods.

32. Applicant's mark HYPERSONIC was not applied for according to its correct type, as shown in its said applications.

33. Upon information and belief, said statement of *intent to use* of the mark HYPERSONIC on the goods in question, was made by an authorized agent of Applicant with the knowledge and belief that said statements was false. Said false statements were made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration.

34. Applicant's mark HYPERSONIC sought to be registered herein is identical to Opposer's mark *HYPERSONIC*.

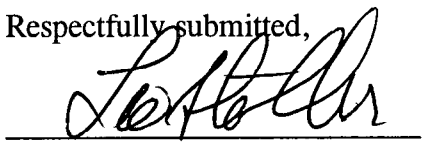
35. Applicant's mark HYPERSONIC, if permitted to register, will cause dilution of Opposer's famous mark *HYPERSONIC*.

36. During the pendency of this opposition, the Applicant attempted to amend its said application without the permission of the Opposer, and without permission of the Board.

WHEREFORE, Opposer prays that said the said Application for the trademark HYPERSONIC be denied, that no registration be issued thereon to Applicant, and that this **Amended Notice of Opposition** be sustained in favor of Opposer and that Opposer is entitled to judgment.

Opposer prays for such other and further relief as may be deemed by the Commissioner of Patents and Trademarks to be just and proper.

Respectfully submitted,



Leo Stoller, President
Central Mfg. Inc.
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773 283-3880 FAX 708 453-0083

Dated: April 8, 2004

DECLARATION

The undersigned, Leo Stoller, declares: that he is President of CENTRAL MFG. INC., and as such, is authorized to execute this document on its behalf, that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Opposer states that CENTRAL MFG. CO. is the owner of the HYPERSONIC mark.

The Opposer submits true and accurate copies of the registration No. 1,593,157 of its HYPERSONIC mark, herein relied upon in support of its Opposition, issued by the Patent and Trademark Office. Attached hereto is a true and correct copy of an April 3, 2001 letter from Mallory Levitt, Esq., counsel for Viacom and Paramount, as well as a true and correct copy of an August 6, 2001 letter by Lance Koonce Esq counsel for the Applicant.

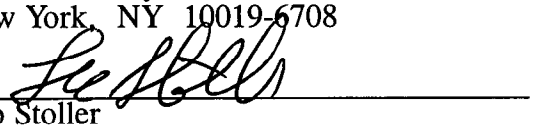
By: _____
Leo Stoller, President
CENTRAL MFG. INC., Opposer
a/k/a CENTRAL MFG. CO.
P.O. Box 35189
Chicago, Illinois 60707
(708) 453-0080

Date: April 8, 2004

Certificate of Service

I hereby certify that this *Amended Notice of Opposition* is being deposited with the U.S. Postal Service by **Express Mail No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce
Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

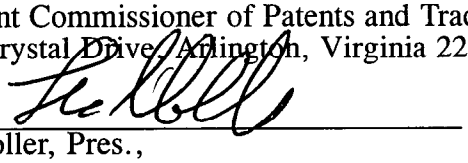


Leo Stoller
Date: April 8, 2004

Certificate of Mailing

I hereby certify that this *Amended Notice of Opposition* is being deposited with the U S Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513



Leo Stoller, Pres.,
Dated: April 8, 2004

D:\MARKS32\PARAM.OPP

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

REGISTRATION NO: 1593157 SERIAL NO: 73771242 MAILING DATE: 02/22/2001
REGISTRATION DATE: 04/24/1990
MARK: HYPERSONIC
REGISTRATION OWNER: CENTRAL MFG CO
CORRESPONDENCE ADDRESS:

LEO D STOLLER
PO BOX 35189
CHICAGO IL 60707-0189

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

****

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

****

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
028.

CLINKSCALES, ARLENE L
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
(703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

Int. Cl.: 28

Prior U.S. Cl.: 22

Reg. No. 1,593,157

United States Patent and Trademark Office Registered Apr. 24, 1990

TRADEMARK
PRINCIPAL REGISTER

HYPERSONIC

S INDUSTRIES, INC. (DELAWARE CORPORATION)
P.O. BOX 348-370
CHICAGO, IL 606348370

FOR: SPORTS RACQUETS, NAMELY TENNIS RACQUETS, RACQUETBALL RACQUETS, SQUASH RACQUETS, BADMINTON RACQUETS; GOLF CLUBS, GOLF BALLS, TENNIS BALLS, SPORTS BALLS, NAMELY BASKETBALLS, BASEBALLS, FOOTBALLS, SOCCERBALLS, VOLLEYBALLS; CROSSBOWS, TENNIS RACQUET STRING AND SHUTTLECOCKS, IN CLASS 28 (U.S. CL. 22).

FIRST USE 1-10-1988; IN COMMERCE 1-10-1988.

SER. NO. 73-771,242, FILED 12-23-1988.

DAVID A. JONES, EXAMINING ATTORNEY

Viacom Inc.
1515 Broadway
New York, NY 10036-5794

Mallory D. Levitt
Counsel

Tel 212 258 6784
Fax 212 846 1729

April 3, 2001

Via Express Mail
Leo Stoller
Hypersonic Brand Products and Services
P.O. Box 35189
Chicago, IL 60707-0189

VIACOM

Re: Your Letter of March 13, 2001

Dear Mr. Stoller:

I am in receipt of your letter of March 13, 2001 addressed to Paramount Parks Inc. ("Paramount"). I have reviewed your claims, and for the reasons set forth below, disagree with your conclusion that Paramount's use of "Hypersonic," "Hypersonic XLC" or "Hypersonic XLC Xtreme Launch Coaster" (collectively, the "Name") constitutes an infringement of your rights in and to the mark HYPERSONIC.

First and foremost, there is no conceivable likelihood that any consumers would be confused by Paramount's use of the Name, and thus that use does not infringe any rights your company may have. As your trademark registration bears out, our clients' uses of the term HYPERSONIC and channels of trade are different, and thus not at all likely to lead to confusion. We understand that your company is using HYPERSONIC in connection with sports equipment including a variety of racquets, clubs and balls. In contrast, my client uses the Name in connection with a roller coaster ride (the "Ride") and tie-in merchandise at its amusement park, PARAMOUNT'S KINGS DOMINION located in Doswell, Virginia (the "Park"). The Ride is the world's first compressed air-launch roller coaster featuring unique acceleration, zero gravity airtime and free-fall sensations. Related merchandise featuring the Name includes apparel, mugs and glasses, key chains, bumper stickers and pennants, all of which are clearly tie-ins to the Ride: They are offered for sale solely within the Park's on-site souvenir and gift shops near the Ride. Thus, consumers will not be confused as to the source of such merchandise. See Hormel Foods Corp. v. Jim Henson Productions, Inc., 26 U.S.P.Q.2d 1812 (S.D.N.Y. 1995)(no likelihood of confusion where use of character name and likeness on merchandise tied to movie). These products are not and will not be available at commercial retail establishments where your sporting equipment is sold. As such, the likelihood of confusion is virtually nonexistent. See Federated Foods, Inc. v. Fort Howard Paper Company, 544 F.2d 1098 (C.C.P.A. 1976); Sun-Maid Raisin Growers of Cal. v. Sunaid Food Products, Inc., 356 F.2d 467 (5th Cir. 1966).

THE OXFORD AMERICAN DICTIONARY 431 (1979) defines the term HYPERSONIC as "1. relating to speeds more that about five times that of sound. 2. relating to sound frequencies above about a billion hertz." As you are no doubt aware, the U.S. Navy developed hypersonic technologies including equipment and missiles using hypersonic aerodynamics. Paramount chose the term HYPERSONIC to exploit this association of the term with speed. Your company cannot claim exclusive rights to use the term in this context.

A brief domestic search confirms the limited nature of protection. That search uncovered third party registrations and applications incorporating HYPERSONIC including: a registration for HYPERSONIC owned by VR-1, Inc. in Class 41 for website gaming services; a registration for HYPERSONIC owned by American Technologies Corporation in Class 9 for sound reproduction equipment; a registration for HYPER SONIC owned by Blitz Manufacturing Company, Inc. in Class 9 for ultrasonic cleaners; an application for HIPERSONIC owned by Systemonic AG in Classes in Classes 9, 16 and 42 for computer programs, publications and consulting/advisory services, respectively; and an application for HYPERSONIC BINGO owned by GLC Limited in Class 41 for online casino games. In addition, there are numerous third party domain name registrations featuring the term HYPERSONIC. This third party use further diminishes any likelihood that a consumer would associate your company's products with Paramount's Ride and related goods.

Finally, Paramount consistently uses the Name with other distinguishing elements such as its stylized logo: all merchandise bearing the Name displays "PARAMOUNT'S KINGS DOMINION" with the Name. Furthermore, all clothing hangtags feature the "house" marks PARAMOUNT with its world-famous Mountain & Stars logo, and PARAMOUNT PARKS. Samples of such use are enclosed for your reference. These clear ties of the Name to the Ride and the Park render it virtually impossible that a consumer would associate Paramount's use of the Name with anyone other than Paramount. Thus, there is no possibility let alone likelihood that any consumer would mistakenly believe that there is any association whatsoever between Paramount's use of the Name and your company's. See Worthington Foods, Inc. v. Kellogg Co., 732 F. Supp. 1417, 14 U.S.P.Q.2d 1577 (S.D. Ohio 1990) (display of company's own familiar mark on product reduces likelihood of confusion which might stem from simultaneous use of another's mark); see also King Research, Inc. v. Shulton, Inc. 324 F. Supp. 631, 169 U.S.P.Q.2d 396 (S.D.N.Y. 1971), aff'd 454 F.2d 66, 172 U.S.P.Q.2d 321 (2d Cir. 1971)(no likely confusion where mark SHIP SHAPE appeared on defendant's products along with OLD SPICE mark and drawing of sailing ship); Pristine Industries, Inc. v. Hallmark Cards, Inc., 753 F. Supp. 140 (S.D.N.Y. 1990)(use of defendant's house mark, *HALLMARK*, in connection with disputed mark is strong factor pointing to no likelihood of confusion).

We trust the foregoing will eliminate your concerns.

Nothing contained herein shall be deemed a waiver of any and all rights of Paramount Parks Inc., all of which are expressly reserved herein.

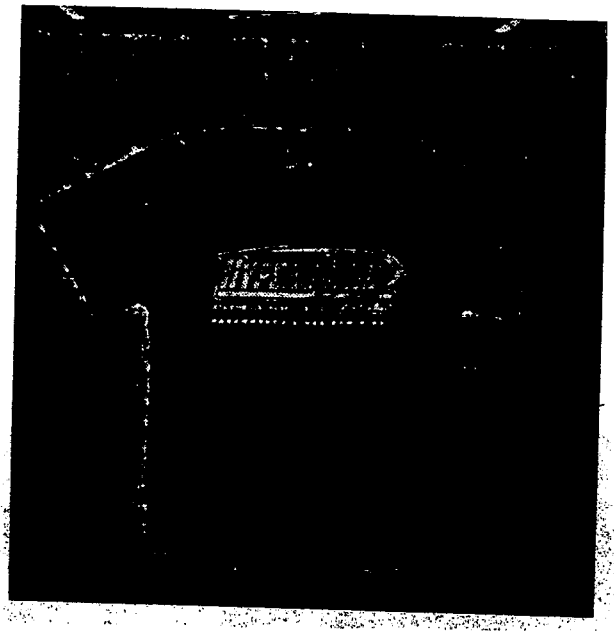
Sincerely yours,

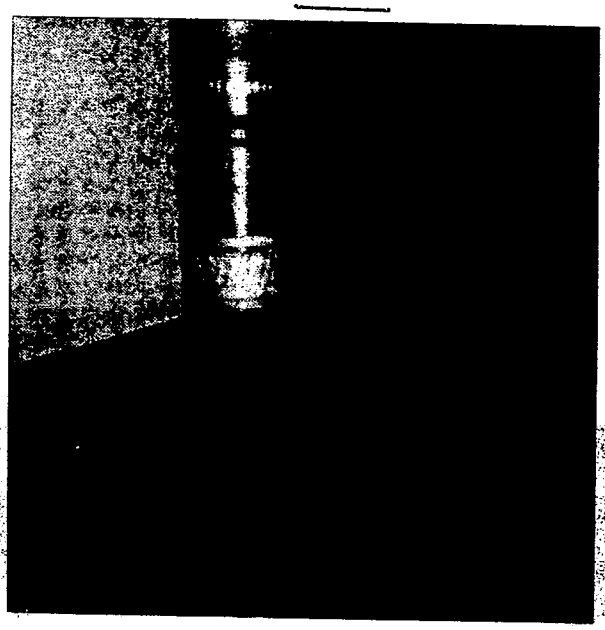
Mallory Levitt

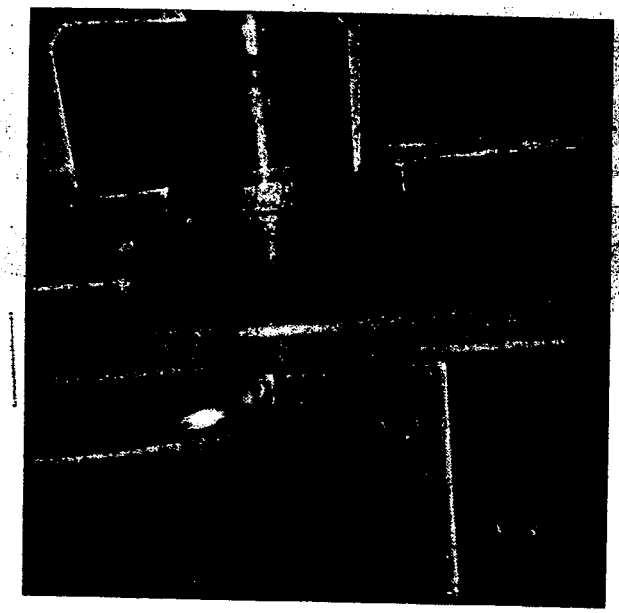
Mallory Levitt

Encl.

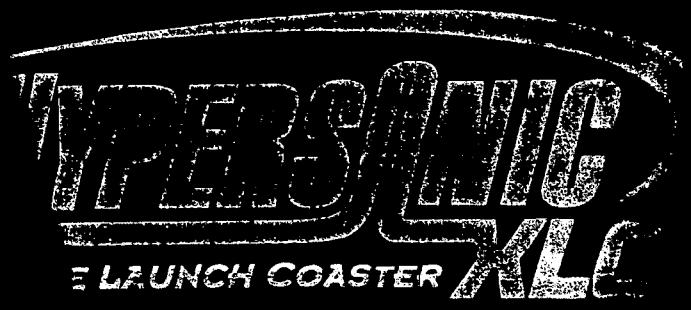
62048

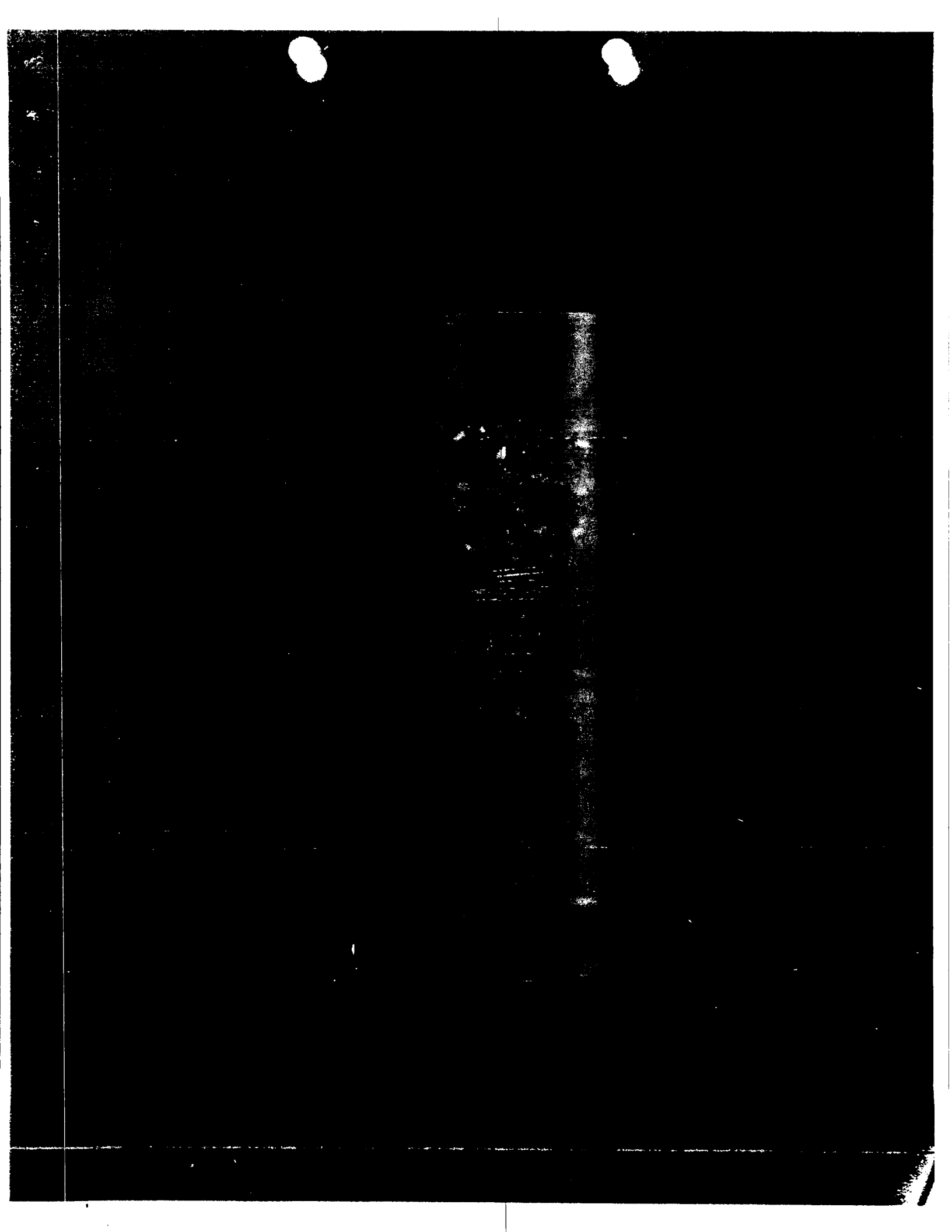






AMOUNT'S KINGS DOMINI






Paramount Parks
A VIACOM COMPANY
HYPERSONIC XLC
XTREME LAUNCH COASTER
PARAMOUNT'S KINGS DOMINION

HYPERSONIC

HYPERSONIC BRAND PRODUCTS & SERVICES *SINCE 1981*
P.O. Box 35189
Chicago, IL 60707-0189
773 283-3880 FAX 708/453-0083 Web site www.rentamark.com

THIS IS FOR SETTLEMENT PURPOSES ONLY HAVING NO EVIDENTIARY VALUE

April 5, 2001

Mallory Levitt
Viacom
1515 Broadway
New York, NY 18036

HYPERSONIC v. HYPERSONIC

Dear Ms. Levitt,

In Re: **SETTLEMENT PROPOSAL:**

Central Mfg. Co. vs. Paramount Park Inc.

Application SN: 76-138,159 TM: HYPERSONIC XLC XTREME LAUNCH COASTER
Application SN: 76-138,156 TM: HYPERSONIC XLC XTREME LAUNCH COASTER
Application SN: 76-103,447 TM: HYPERSONIC
Application SN: 76-138,161 TM: HYPERSONIC XLC XTREME LAUNCH COASTER
Application SN: 76-138,160 TM: HYPERSONIC XLC XTREME LAUNCH COASTER
Application SN: 76-138,150 TM: HYPERSONIC XLC XTREME LAUNCH COASTER
Application SN: 76-103,448 TM: HYPERSONIC

Thank you for your quick response to our cease and desist letter. We have read your letter (brief) with considerable interest. You cite a lot of cases and appear to know the trademark law as it relates to likelihood of confusion.

However, as you are well aware, in this the 21st Century, there are no well known trademarks that are available, that have not already been registered or belong to other third parties, as in the case at bar.

Secondly, Ms. Levitt, you are also well aware that if a trademark holder is not willing to step up to the plate to police its property, it will have no intellectual property to police.
It is our position in this case that our mark HYPERSONIC is a well known incontestable

trademark, that has clear[redacted] ɛved *secondary meaning*. It is fu[redacted] ˈur position that we not only claim rights to an incontestable HYPERSONIC trademark Reg. No. 1,593,157, but we also hold common law rights to the mark HYPERSONIC on a broad range of goods and services similar to the type that your client's mark is used for.

Thirdly, it is our position, that the types of goods and services, that we are marketing under our HYPERSONIC trademark our marketed to the same type of customers that will be visiting Paramount Parks, Inc. and purchasing your client's HYPERSONIC goods. Notwithstanding our claims that likelihood of confusion may exist between your client's use of the mark HYPERSONIC and our HYPERSONIC mark, there are good business reasons any District Court Judge will suggest for parties to resolve their trademark controversies amicably.

In response to your suggestion that their are other third parties who may be using the mark HYPERSONIC, is no defense against your client's alleged, unauthorized use of the HYPERSONIC mark, as well known to you.

Thus, we are proposing the following three settlement proposals that would settle this matter without the need for Court intervention.

Please advise which of the attached proposals your client may be interested in.

If you have any questions, please call.

Most cordially,

Leo Stoller, President

Attachments

C:\WS\MARKS22\HYPERSON.AGR

WHY OBTAIN A *HYPERSONIC*® LICENSE...

Americans are brand conscious. More than 95 percent of all products sold in America are branded goods and more than $120 billion is spent in advertising to create and maintain brand images for those products. The reason: Consumers' buying habits are tied to how they think and feel about a brand.

In today's competitive marketplace, the licensing of brand names for new products - essentially, borrowing an established brand name in order to sell more product - has become increasingly prevalent. Sales of licensed products in the U.S. now total more than $151 billion a year and over 40% of all goods sold are licensed products.

The reasons are simple. Building a brand image for a new product is extremely costly. And there's no guarantee that an expensive brand image campaign will work. Licensing your products and services under an established trademark brings instant recognition and acceptance with your customers. Licensing endows your products and services with the power of the images carried by the brand name trademark, giving you the opportunity to:

* Introduce products more easily and enter the market from a position of strength.

* Achieve instant customer awareness and help increase market share without risking large marketing expenditures.

* Create instant enthusiasm and interest among your customers.

* Sell a greater volume of products or services due to your customers' increased interest.

* Sell your products or services for a greater profit margin.

* Avoid trademark litigation.

Licensing an established trademark for your products or services just makes good business sense. The enormous power of ***HYPERSONIC***® trademarks can mean instant buyer appeal for your products and services. As a ***HYPERSONIC***® licensee, you are part of a team company already marketing their products and services using ***HYPERSONIC***® trademarks. Their success is proof of what a ***HYPERSONIC***® license can do for you.

HYPERSONIC® LICENSING PROGRAM

Licensee Requirements

As a prerequisite for becoming a ***HYPERSONIC***® licensee, a distributor, manufacturer or service company should consider the following requirements:

PRODUCT OR SERVICE CATEGORY:

An appropriate product category that would utilize and compliment the ***HYPERSONIC***® image.

MARKETING:

A proven track record of marketing.

RESOURCES:

Adequate resources - production, financial and manpower to undertake such an expanded program.

STYLING AND QUALITY:

Ability to ensure good styling and consistent quality products or services.

PRODUCTION:

Efficient manufacturing and/or sourcing to ensure on-time delivery of value packed products.

OBJECTIVES:

Long-term objectives of continued growth in sales and profits.

To an increasing extent, all types of buyers, including buyers for mass market retail outlets, are demanding brand names with image. Their customers want established brand names as a guarantee of quality, value and good styling. More and more manufacturers are being encouraged to provide brand names in order to maintain and expand their market position. Some companies who already have one or more brand names are seeking additional identification programs due to their demonstrated success with branded goods and services. Others, who have no brands or the wrong brands, need a brand to survive.
For companies that qualify, the ***HYPERSONIC***® brand could be the answer.

HYPERSONIC® LICENSING PROGRAM

See Rentamark famous brands available for licensing at www.rentamark.com

The nature of the major terms of the License Agreement are indicated hereunder.

ROYALTY RATE:

Royalty rates are a negotiable percent of the sale price charged by Licensee for each licensed product and/or service sold.

TERM OF AGREEMENT:

Basic life of agreement coordinated with requirements of product development; usually three or more contract years, with the first contract year being long enough to allow "start-up" time.

MINIMUM SALES:

Minimum sales target projections mutually determined.

MINIMUM ROYALTIES:

Annual guaranteed minimum royalty realistically assessed.

ADVANCE PAYMENT:

A reasonable portion of the Minimum Royalties (not an additional fee).

RENEWALS:

Renewal terms based on performance to capitalize upon success of the program.

LICENSING *HYPERSONIC*® ENABLES YOU TO ...

* DIFFERENTIATE AMONG PARTY PRODUCTS

* ENJOY EASIER TRADE ACCEPTANCE

* JUSTIFY A PREMIUM PRICE POINT

* GENERATE QUICK CONSUMER TRIAL

* ACHIEVE SIGNIFICANT MARKET SHARE QUICKLY

* AVOID TRADEMARK LITIGATION

STEALTH®, SENTRA®,TERMINATOR®,
HYPERSONIC® & DARK STAR®

D/B/A
RENTAMARK.COM
P. O. Box 35189
Chicago, IL 60707-5189
Phone: (773) 283-3880 Fax: (708) 453-0083
Email: info@rentamark.com

See our list of other famous brands available for licensing at www.rentamark.com
Contact us about representing and licensing your brand

PROTECT YOUR COMPANY'S ASSETS WITH
A *RENTAMARK®* BRAND TRADEMARK LICENSE

Pick the wrong name for your new product or service and you stand to LOSE BIG TIME! That's what lots of companies learn when they find themselves on the wrong side of a trademark infringement action. Over $2 billion was spent last year in litigation and legal expenses due to **misuse of trademarks.** And it's not only the Fortune 500 firms who get hurt. It's the small to mid-size companies with little experience in trademark law, who often don't find out until an attorney sends a warning letter to "cease and desist" or you get served with a Federal Trademark infringement lawsuit.

Any company can pay hundreds of thousands of dollars in legal expenses fighting an infringement suit with no guarantee of success. If you lose, you'll not only have to rename your product, reprint all the sales literature, and redo the advertising, you'll also **suffer a major loss** of credibility with your customers ..... and possibly owe treble damages to the winner and attorneys' fees. For many, the enormous legal expenses of defending a trademark dispute can literally mean the END OF YOUR BUSINESS.

Now you can protect your business with a ***RENTAMARK®*** famous brand trademark license agreement. Merely choose a ***RENTMARK®*** brand famous trademark for use on your product or service and allow ***RENTAMARK®*** to police and protect the trademark.

Some of our famous brand names include, but are not limited to:

SENTRA®
STEALTH®
DARK STAR®
TERMINATOR®
AIRFRAME®
HYPERSONIC®
NIGHT STALKER®
STRADIVARIUS®
TRILLIUM®

Visit our website at: WWW.RENTAMARK.COM

HYPERSONIC

HYPERSONIC BRAND PRODUCTS & SERVICES *SINCE 1981*
P.O. Box 35189, Chicago, IL 60707-0189
VOICE 773/283-3880 * FAX 708/453-0083 * WEB PAGE: www.rentamark.com

FOR SETTLEMENT PURPOSES ONLY HAVING NO EVIDENTIARY VALUE

July 24, 2001

Mallory Levitt
VIACOM INC.
1515 Broadway
New York, NY 10036-5794
Phone: (212) 258-6784
Fax: (212) 846-1428

Re: Paramount Parks, Inc., HYPERSONIC
Application Numbers: 76-103,447 and 76-103,448

Dear Ms. Levitt:

We are writing to inform you that we have filed requests to file a Notice of Extension to Oppose. Paramount Parks trademark applications 76-103,447 and 76-103,448.

As you are fulled aware, we hold rights to the mark HYPERSONIC, registration no. 1,595,157 for a broad range of closely related goods. We also hold common law rights to the mark HYPERSONIC on numerous other goods and services which we will rely upon to defeat PARAMOUNT PARK'S applications for the mark HYPERSONIC at the Trademark Trial & Appeal Board.

Nonetheless, we view the controversy that exists as between the parties as a registerability controversy which will be resolved by the Trademark Trial and Appeal Board. The record in this case should be clear; we are not threatening Viacom or it's subsidiary, Paramount Parks, Inc., with any District Court action. We are not threatening any of Viacom or Paramount Parks' customers with any District Court action. Consequently, we are not going to file nor are we threatening to file a District Court case against Viacom and/or Paramount Parks.

We have until August 20, 2001, to file our Notice of Oppositions to the said applications, 76-103,447 and 76-103,448. The Board encourages parties to resolve registerability conflicts in order to avoid long and contentious oppositions proceedings. You will recall that we previously engaged, and successfully opposed another subsidiary of Viacom's seven trademark applications for the mark STEALTH FORCE over a five year period. In order to resolve the

current registerability conflict regarding Viacom's attempt to register the HYPERSONIC mark, we are proposing two settlement proposals which would applicably resolve the registerability controversy as between the parties, avoiding a long and contentious and costly opposition proceeding; please find attached.

On the other hand, if Paramount Parks, Inc. would merely file an Express Abandonment with prejudice of it's applications, bearing the mark HYPERSONIC, we will consider this registerability conflict resolved.

Most Cordially,

Leo Stoller

KAY COLLYER & BOOSE LLP
ONE DAG HAMMARSKJOLD PLAZA
NEW YORK, N.Y. 10017-2299
(212) 940-8200

TELECOPIER: (212) 755-0921

WRITER'S DIRECT DIAL NUMBER

August 6, 2001

VIA FAX (708) 453-0083
and CERTIFIED MAIL

Mr. Leo Stoller
Hypersonic Brand Products and Services
and Central Manufacturing Co.
P.O. Box 35189
Chicago, IL 60707-0189

Re: HYPERSONIC

Dear Mr. Stoller:

We write as counsel to Paramount Parks Inc. ("Paramount"), a division of Viacom International Inc., in response to your letter of July 24, 2001 to Mallory Levitt, regarding Paramount's trademark applications Nos. 76-103447 and 76-103448. As a preliminary matter, we reiterate, as requested in the letter of Marcia B. Paul of this office dated April 25, 2001, that you communicate with our client regarding the above-referenced mark through this firm.

As to the substance of your letter, as we have previously advised, Paramount rejects your frivolous claims and extortionate settlement demands. We find it frankly astonishing that after our very clear statements in this regard, you continue to waste your own time and that of our client by forwarding settlement proposals for Paramount's review. We restate Paramount's position:

> Paramount respects the intellectual property rights of others and vigilantly acts to police and protect its own marks. But it will not pay someone whose rights have not and could not be violated, simply to avoid litigation. For this reason, be advised that *Paramount will not entertain any settlement proposals regarding, nor will it negotiate for settlement of any dispute over, the Marks,*

unless ordered to do so by a court or other legal authority.

The foregoing is written without prejudice to or waiver of all of our client's rights in and to the premises, all of which are expressly reserved.

Sincerely yours,

Lance Koonce

MBP/lp

cc: Michelena Hallie, Esq.
Mallory Levitt, Esq.

IN THE UNITED PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CENTRAL MFG. CO.
(a Delaware Corporation)
P.O. Box 35189
Chicago, IL 60707-0189

Opposer,

vs.

PARAMOUNT PARKS, INC.
8720 Red Oak Blvd.
Charlotte, NC 28217

Applicant

Opposition No: 91123765

Trademark: HYPERSONIC

04-12-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

/
Box TTAB/NO FEE

MOTION FOR RECONSIDERATION OF BOARD ORDER DATED MARCH 9, 2004

NOW COMES the Opposer and requests that the Board reconsider its decision of March 9, 2004, and states as follows:

First of all, it is important to point out that the Board abused its discretion by refusing to grant Opposer's motion to file a brief in excess of 25 pages in support of its motion for summary judgment. The Opposer requested that the Board grant its motion to permit Opposer's brief, which was slightly in excess of twenty-five pages. The Opposer, who has been involved with the FRCP and District Court litigation involving trademarks for over twenty-five years, has never heard or been involved in a case where the District Court would not have granted a movant leave to accept a brief which was a page or two in excess of the page limit. The Opposer asserts in this case the Board's failure to grant Opposer's motion to accept its brief which was one or two pages in excess of 25, represents a bias and prejudice towards the Opposer in favor of the Applicant. There is no other interpretation possible. Thus, the Opposer would like to give the Board its opportunity to reconsider that decision and to grant Opposer's motion for leave to file its brief in excess of 25 pages, to establish that this Board, consisting of Judges Bottorff, Rogers and Drost, were not biased and prejudiced against the Opposer.

The Board further found at page 6 of its decision of March 9, 2004:

"After reviewing the arguments and supporting papers of the parties, we find that opposer has not met its burden of establishing that genuine issue of material fact exists as to any of the grounds on which it bases its motion for summary judgment. In view of the facts that (1) applicant has filed a counterclaim to cancel opposer's pleaded registration based on a claim of abandonment and (2) there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce, a genuine issue of material fact exists as to whether opposer has standing to maintain this proceeding."

The Board's conclusion that there is a genuine issue of material fact as to whether Opposer has standing to maintain this proceeding, was in error, as the Board considered Opposer's declaration to its motion for summary judgment "based solely on Mr. Stoller's capacity as opposer's president, at page 4. The Board, at page 7, is inconsistent in its above finding, in its footnote 8, for the Board contradicts itself by attempting to interpret Opposer's declaration differently than the Board's initial acceptance to limit the Board's interpretation of Leo Stoller's declaration, "based solely on Mr. Stoller's capacity as opposer's president", on page 4.

Further, the Board erred in stating on page 7 that "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce ...". The Opposer has pled a valid registration for the mark HYPERSONIC. A registration(s) on the Principal Register is prima facie evidence of the validity of the registered mark, of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark **Similarly a federal registration resulting from a use-based application is prima facie evidence that the mark has been used in interstate commerce prior to registration.**

The fact that the applicant has pled a counterclaim for cancellation of Opposer's pled registration based on a claim of abandonment, without any proof whatsoever, does not automatically shift the burden of the registrant to establish proof of use of a registered trademark that has reached the incontestable status. This principle in law is well-known to the Board

members. The applicant has put into the record nothing whatsoever that establishes the Applicant's abandonment claim. Barring which, the Opposer in its motion for summary judgment, is under no obligation to present anything other than its valid Federal trademark registration which establishes its presumption of use. Applicant's boilerplate counterclaim for abandonment does not, per se, destroy the said registrant's presumption of use. Consequently, had the Board followed the law, the facts and the evidence in this case, it would have not found necessary for the Opposer in its motion for summary judgment to have had to include any evidence of use other than a copy of Opposer's valid, incontestable Federal trademark registration.

As a result, the Opposer asserts that the Board clearly erred in its finding that "... there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce ...", page 7. The Opposer requests, respectfully, that the Board reconsider its said erroneous finding and to rewrite its finding pursuant to the current law which states that there is a heavy burden of proof on the counterclaimant[1].

"The burden of proof is on the party claiming abandonment. Because abandonment is in the nature of a forfeiture, the burden of proof is a heavy one[2]. One decision characterized the burden as requiring evidence that 'leaves no room for doubt or speculation' and leads to ' but not inescapable conclusion, namely, that the use of the mark was discontinued with intent to abandon it to the world.[3]' On the other hand, another decision described the burden of proof for abandonment in a cancellation action as a preponderance of the evidence, the same as the burden for likelihood of confusion. Once non-use has been proven, the burden of production (not the burden of proof) shifts to the registrant."

---

1. See Third Edition, Trademark Law, A Practitioner's Guide, by Siegrun D. Kane, §11-19, The Heavy Burden of Proof.

2. *Saratoga Vichy Spring Co. v. Lehman,* 625 F.2d 1037, 1044 (2d Cir. 1980).

3. Miller Brewing Co. v. Oland's Breweries, Ltd., 189 U.S.P.Q. 481, 488 (TTAB 1975), aff'd, 548 F.2d 349 (CCPA 1976).

The Board, in the Opposer's decision, made an absolute egregious abuse of its discretion and/or clear error, when it stated at page 7 that "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce...". The Board, this panel of Judges, already assumed that the Applicant has met its heavy proof of non-use, and that the burden of production had shifted to the Registrant/Opposer. When in fact the Applicant has not met its burden of production, proving the Registrant's non-use, and the burden has not shifted to the Registrant. Consequently, a fair and impartial panel of Trademark Trial and Appeal Board Judges, the Opposer respectfully asserts, would not have come to the conclusion that "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce ...". The Board violated the Opposer's Due Process and Equal Protection Rights by not giving the Opposer's said Registration the statutory presumption of use which it was entitled to under the law. Thus, the Board should reconsider and reverse its finding that relates to the *prima facie* validity of Opposer's Registration which has not been satisfactorily met by the Applicant.

The Board further found, "in addition, at minimum, genuine issues exist as to whether the goods at issue are related in a manner that would cause prospective purchasers to have a mistaken belief that they come from the same source, and as to whether applicant's intended use of the mark on the goods would constitute use in commerce."

There could be no question that the goods of the parties need not be identical or directly competitive to find likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.,* 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.,* 22 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.,* 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.,* 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i). In this case, there can be no question that the goods of the parties are similar, related and/or competitive, and could be used in conjunction with the

Registrant's goods. The Board must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.,* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

Furthermore, it is clear that Applicant's intrastate use of the mark on the goods does not constitute use in commerce. The Board's finding that the Opposer's motion for summary judgment was denied in all respect was clear error and/or abuse of discretion. The Board, Judges Bottorff, Rogers and Drost, have a lawful obligation to follow the current law based upon the facts and the evidence presented by the Opposer. The Opposer respectfully asserts that the Board could have, within its discretion, ruled in favor of the Opposer's motion for summary judgment, but chose not to strictly follow the facts and the law in this case for the reasons previously stated.

The Opposer strongly objects to the Express Mail sanction that has been leveled on the parties. The Opposer asserts that the sanction imposes a burdensome, oppressive and unnecessary hardship on the Opposer in violation of its Due Process and Equal Protection Rights. The Board clearly found at page 9 that the "Applicant has submitted no evidence, such as copies of a postmark envelope in which the responses were enclosed, to rebut that prima facie proof of service. Cf. *S. Industries, Inc. v. Lamb-Weston, Inc.,* 45 USPQ 2d 1293 (TTAB 1997). Accordingly, we find that applicant has not met its burden of proof with regard to its allegation that opposer's discovery responses were not timely served in compliance with the July 24, 2002 order."

In view of the fact that the Applicant did not meet its burden of proof that Opposer's discovery responses were not timely served, does not justify in any manner, shape or form, this Board's sanction of Express Mail delivery which the Board has imposed upon the parties. The Opposer, as well-known to Judges Bottorff, Rogers and Drost, has over 50 inter-party proceedings pending before this Honorable Board, and that various members of this Board are attempting to impose an express mail delivery sanction on the Opposer in each and every proceeding in which the Opposer is involved in order to deprive the Opposer of its ability to fairly litigate before the TTAB. This imposition, under these circumstances of an expensive express mailing sanction, which is not justified, directly violates the Opposer's Due Process

and Equal Protection Rights under the 5th and 14th Amendments of the U.S. Constitution. The Opposer is requesting that the Board reverse its express mail sanction in this proceeding and permit the parties to make mailings by first class United States mail.

WHEREFORE, the Opposer prays that the Board reconsider its decision of March 9, 2004, and to reverse those contested findings cited herein by the Opposer, to withdraw the express mail sanction placed upon the parties, and to grant Opposer's motion for summary judgment as a matter of law.

By: Leo Stoller

Leo Stoller
CENTRAL MFG. CO., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773-283-3880 FAX 708 453-0083

Date: April 8, 2004

Certificate of Service

I hereby certify that this *Motion for Reconsideration* is being deposited with the U.S. Postal Service by **Express Mail No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce
Lance Koonce
DAVIS WRIGHT TREMAINE LLP.
1633 Broadway
New York, NY 10019-6708

Leo Stoller
Date: April 8, 2004

Certificate of Mailing

I hereby certify that the foregoing *Motion for Reconsideration* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE
Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive, Arlington, Virginia 22202-3513

Leo Stoller
Date: April 8, 2004

D:\MARKS32\PARAM.DEP

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Baxley

Mailed: March 9, 2004

Opposition No. **91123765**

CENTRAL MFG. CO.

v.

PARAMOUNT PARKS, INC.

Before Bottorff, Rogers and Drost,
Administrative Trademark Judges.

By the Board:

Paramount Parks, Inc. ("applicant") seeks to register the mark HYPERSONIC in typed form for "paper goods and printed matter, namely calendars, fiction magazines, comic books, greeting cards, posters, a series of fiction books, trading cards, stickers, notepads, notebooks, postcards, gift wrapping paper, bumper stickers, rubber stamps" in International Class 16[1] and "T-shirts, sweatshirts, hats, jackets, pajamas, masquerade costumes, tank tops, footwear, sweatpants, [and] shorts" in International Class 25.[2]

Central Mfg. Co. ("opposer") has opposed registration of applicant's mark on grounds that the mark is likely to

[1] Application Serial No. 76103448, filed August 2, 2000, based on an assertion of a bona fide intent to use the mark in commerce.

cause confusion with opposer's previously used and registered mark HYPERSONIC under Trademark Act Section 2(d),[3] 15 U.S.C. Section 1052(d); that registration of applicant's mark will cause dilution of opposer's "famous" mark; that applicant's involved applications were "obtained fraudulently" because, in view of the fact that applicant was already using the mark at the time it filed its applications, applicant's assertions of a bona fide intent to use the mark in commerce were false; that applicant's involved applications were "obtained fraudulently" because applicant asserted a bona fide intent to use the mark in commerce when it never intended to use its mark in commerce; that applicant's involved applications were obtained fraudulently because applicant had no right to register its mark; that applicant did not have a "valid" intent to use the mark in commerce and has no right to register its mark; that applicant had been using the HYPERSONIC mark prior to filing its involved intent-to-use applications; that applicant's mark is merely descriptive or deceptively misdescriptive of its goods; and that the mark as set forth

---

[2] Application Serial No. 76103447, filed August 2, 2000, based on an assertion of a bona fide intent to use the mark in commerce.

[3] Registration No. 1593157 for "sports racquets, namely tennis racquets, racquetball racquets, squash racquets, badminton racquets; golf clubs, golf balls, tennis balls, sports balls, namely basketballs, baseballs, footballs, soccerballs, volleyballs; crossbows, tennis racquet string and shuttlecocks" in International Class 28, issued April 24, 1990.

in the application is not a substantially exact representation of the mark intended to be used with the identified goods. Applicant denied the salient allegations of the notice of opposition and asserted affirmative defenses in its answer and filed a counterclaim to cancel opposer's pleaded Registration No. 1593157.

This case now comes up for consideration of (1) opposer's combined motion (filed October 15, 2002) for summary judgment, for oral hearing on that motion, and for leave to file a brief in excess of twenty-five pages;[4] (2) applicant's motion (filed April 11, 2003) for discovery sanctions, which was included in its brief in response to opposer's motion for summary judgment; and (3) opposer's motion (filed May 27, 2003) for sanctions under Fed. R. Civ. P. 11.

---

[4] In a declaration submitted with exhibits in support of opposer's motion for summary judgment, declarant Leo Stoller, who executed the declaration in both his individual capacity and as president of opposer, refers to himself as "the Opposer and President of CENTRAL MFG. CO." and claims to own pleaded Registration No. 1593157. We note, however, that the notice of opposition identifies Central Mfg. Co. as the sole opposer herein. As opposer is well aware, a corporation is a separate legal entity. See *Timex Corporation v. Leo Stoller d/b/a Sentra Sporting Goods U.S.A. Co.*, 961 F. Supp. 374 (D.C. Conn. 1997) ("Stealth Industries is a Delaware corporation, an independent entity from Leo … Stoller."). Inasmuch as no document reflecting the assignment of pleaded Registration No. 1593157 to Mr. Stoller has been filed with the Board or recorded with the USPTO's Assignment Branch, neither joinder nor substitution of Mr. Stoller as a party to this proceeding is appropriate. See TBMP Section 512.01. Further, inasmuch as Mr. Stoller is not a party to this proceeding, we will not consider any papers filed by him individually unless and until he is joined or substituted as a party plaintiff herein. Nonetheless, we will consider the

Opposer's motion to file a brief in excess of twenty-five pages is denied

We turn first to opposer's motion to file a brief in excess of twenty-five pages in support of its motion for summary judgment. Opposer's initial filing in support of its motion for summary judgment consists of two briefs, i.e., a seventeen-page "verified motion for summary judgment with supporting memorandum" and a separate ten-page "verified memorandum."

Trademark Rule 2.127(a), as amended, states in relevant part: "[t]he brief in support of the motion and the brief in response to the motion shall not exceed [twenty-five] pages in length." As was stated in the Notice of Final Rulemaking in which the twenty-five page limitation was adopted, "[i]t is believed that [twenty-five] … pages [is] sufficient for the main brief … of any motion that arises in a Board *inter partes* proceeding. Because of the limited nature of Board proceedings, briefing for motions in such proceedings should not be as extensive as that in proceedings in court." Notice of Final Rulemaking, 63 Fed. Reg. 48081, 48094 (September 9, 1998). See *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220 (TTAB 2003). Taken together, opposer's combined briefs exceed the twenty-five page limit. While opposer contends

---

declaration based solely on Mr. Stoller's capacity as opposer's president.

that it needs additional pages to fully inform the Board of the facts and issues of this case, opposer should have, under the circumstances, been able to inform us of the facts and issues of this case in a single brief of less than twenty-five pages.[5]

In view thereof, opposer's motion to file a brief in excess of twenty-five pages is hereby denied. Accordingly, we have considered the "verified motion for summary judgment with supporting memorandum," but have not considered the "verified memorandum."[6]

Opposer's motion for an oral hearing on its motion for summary judgment is denied

We find that the parties' arguments with regard to opposer's motion for summary judgment are adequately presented in the parties' briefs thereon. See TBMP Section 502.03. Accordingly, opposer's motion for an oral hearing on its motion for summary judgment is hereby denied.

Opposer's motion for summary judgment is denied

Opposer seeks entry of summary judgment on the grounds that there is a likelihood of confusion between its pleaded mark and applicant's mark; that Viacom, Inc., not applicant,

---

[5] Further, Trademark Rule 2.127(a), however, limits a moving party to a brief in support of its motion and a reply brief, which the Board may, in its discretion, consider, and specifically states that no further papers will be considered. As such, opposer's piecemeal briefing of its motion for summary judgment is inappropriate.

[6] We hasten to add that consideration thereof would not have changed our decision herein.

owns the involved mark; that applicant's failure to disclose its relationship with Viacom is fatal to its applications; that applicant does not have a valid intent to use the mark because it merely intended to use its mark in intrastate commerce; that applicant has not established a valid first use date; that the mark in the drawing is not a substantially exact representation of the mark as used in the specimens of use that were submitted with its amendments to allege use; that applicant did not have a bona fide intent to use the mark when it filed its applications and did not have actual use when it filed its "Statements to Amend Use"; that the involved marks were not applied for in their correct type; and that applicant made misrepresentations to the Board in its amendments to allege use.

After reviewing the arguments and supporting papers of the parties, we find that opposer has not met its burden of establishing that no genuine issue of material fact exists as to any of the grounds on which it bases its motion for summary judgment.[7] In view of the facts that (1) applicant

---

[7] We note that opposer's grounds for its summary judgment motion that applicant is not the owner of the involved mark and that applicant has failed to disclose the nature of its relationship with Viacom, Inc., as well as all of opposer's grounds related to applicant's use of the mark are unpleaded and that applicant has objected on that basis. See TBMP Section 528.07. Accordingly, opposer may not obtain summary judgment on any of those grounds.

has filed a counterclaim to cancel opposer's pleaded registration based on a claim of abandonment and (2) there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce, a genuine issue of material fact exists as to whether opposer has standing to maintain this proceeding.[8] In addition, at minimum, genuine issues exist as to whether the goods at issue are related in a manner that would cause prospective purchasers to have a mistaken belief that they come from the same source, and as

---

Moreover, we note that applicant's applications are filed based on applicant's assertion of a bona fide intent to use in commerce under Trademark Act Section 1(b). Accordingly, any issues regarding the methods in which applicant uses the mark are prematurely raised. See TMEP Sections 1102.01 and 1202. Although applicant filed amendments to allege use in connection with both applications, those amendments to allege use are untimely filed and therefore a nullity. See TMEP Section 1104.03(c). Further, opposer's allegations regarding applicant's specimens of use of its mark are an *ex parte* examination issues, which may not be grounds for opposition or cancellation. Cf. *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355 (TTAB 2003); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989).

[8] We further note that the declaration in support of opposer's motion for summary judgment states that Leo Stoller, not opposer, is the owner of the pleaded registration relied upon as a basis for the Section 2(d) claim. Such declaration also raises a genuine issue of material fact as to opposer's standing to maintain this proceeding. Although opposer contends that it has adequately pleaded its standing, an adequate pleading of one's standing does not establish that there are no disputed issues related to standing and that opposer is entitled to judgment as a matter of law.

to whether applicant's intended use of the mark on the goods would constitute use in commerce.[9]

In view thereof, applicant's motion for summary judgment is hereby denied in all respects.[10]

Applicant's motion for discovery sanctions is denied

Applicant has moved for entry of judgment as a discovery sanction.[11] In a July 24, 2002 order, opposer was "ordered to respond to any of applicant's outstanding discovery requests" and was allowed until thirty days therefrom to do so. Accordingly, opposer was allowed until not later than August 23, 2002 to serve responses to applicant's discovery requests. Applicant contends that, while the certificates of service on opposer's responses to its discovery requests state that those responses were served on August 21, 2002, it did not receive them until September 3, 2002. Applicant further contends that those

---

[9] The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

[10] The parties should note that the evidence submitted in connection with opposer's motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

[11] Although not stated specifically, applicant's motion for discovery sanctions is pursuant to Trademark Rule 2.120(g).

responses were deficient.[12] Accordingly, applicant asks that the Board enter judgment against opposer.

Although applicant's contentions regarding opposer's president's alleged assertions that the mail was slow outside Chicago raise serious questions as to the timeliness of service of opposer's discovery responses, the certificates of service included therein constitute *prima facie* proof of service. See Trademark Rule 2.119(a). Applicant has submitted no evidence, such as copies of a postmarked envelope in which the responses were enclosed, to rebut that prima facie proof of service. Cf. *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997). Accordingly, we find that applicant has not met its burden of proof with regard to its allegation that opposer's discovery responses were not timely served in compliance with the July 24, 2002 order.[13]

With regard to the alleged deficiency of those responses, we note that the Board, in the July 24, 2002

---

[12] A review of those responses indicates that, on August 21, 2002, opposer served written responses to applicant's first request for production and a general objection to applicant's first set of interrogatories based on their alleged excessive number. Opposer served amended responses to applicant's first set of interrogatories on September 25, 2002 that include responsive information regarding only sixteen of applicant's twenty-eight interrogatories and has not produced any documents responsive to applicant's first request for production.

[13] Moreover, in view of the fact that applicant's counsel received opposer's initial discovery responses shortly after the date specified in the July 24, 2002 order, entry of judgment as a sanction would be an unduly harsh remedy at this time.

order, reset opposer's time to serve discovery responses, but did not compel discovery.[14] We further note that applicant did not file a motion to compel discovery in the time between the expiration of opposer's time to serve discovery responses in accordance with that order and the issuance of the Board's October 17, 2002 order which suspended proceedings herein pending disposition of opposer's motion to dismiss the counterclaim. See Trademark Rule 2.120(e)(1). Inasmuch as no order compelling discovery has been violated herein and opposer served responses to applicant's discovery requests, applicant's motion for discovery sanctions is premature. See Trademark Rule 2.120(g)(1); TBMP Section 527.01 (2d ed. June 2003).

In view thereof, applicant's motion for discovery sanctions is hereby denied.

Use of Express Mail required for all papers henceforth

To avoid further disputes with regard to the timeliness of service of papers in this proceeding, the Board, in exercising its inherent authority to control the conduct of parties in this proceeding, will only consider papers filed by the "Express Mail" procedure described in Trademark Rule 1.10 or by another overnight courier. Additionally, each party is hereby ordered to serve all papers on its

---

[14] Any alleged deficiencies in opposer's responses to applicant's discovery requests must first be raised by way of a motion to

adversary, as required by Trademark Rule 2.119(a), by the "Express Mail" procedure described in Trademark Rule 1.10, including a sworn certificate of service by "Express Mail," or by another overnight courier.

Standard protective order imposed

In view of the contentious nature of this proceeding, the Board hereby imposes its standard protective order published in the *Official Gazette* on June 20, 2000 at 1235 TMOG 670.[15] A copy of the Board's standard form order is enclosed with each party's copy of this order.

Opposer's motion for Fed. R. Civ. P. 11 sanctions is denied

Turning to opposer's motion for sanctions under Fed. R. Civ. P. 11, we note initially that opposer set forth such motion as a separate filing and served it on April 25, 2003, twenty-five days before filing it with the Board. As such, opposer has complied with the safe-harbor provisions of Rule 11(c)(1)(a). However, with regard to the merits of opposer's motion, which is based on allegations previously set forth in its combination reply brief in connection with its summary judgment motion and response to applicant's motion for discovery sanctions, we find that entry of sanctions against applicant is inappropriate.

---

compel. See Trademark Rule 2.120(e)(1); TBMP Sections 523. See also TBMP Section 527.01.

[15] An electronic copy is available from the PTO website at http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm

Opposer contends that the amendments to allege use that applicant filed in connection with its applications on October 26, 2001, i.e., during the pendency of this proceeding, are in violation of Trademark Rule 2.133(a) and thus should result in refusal of registration of the mark in both applications as a sanction. An amendment to allege use, however, is filed with the Trademark Examining Group of the USPTO as part of the *ex parte* examination of the application and does not constitute a pleading, motion, or other paper filed with the Board. Accordingly, the filing of an amendment to allege use does not fall within the purview of Rule 11.[16] Rather, applicant's amendments to allege use and the filing fees submitted therewith should not have been accepted and should have been returned to applicant.[17] See *In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm'r Pats. 1991); TMEP Section 1104.03(c).

Opposer also contends that applicant should be sanctioned for filing a motion for discovery sanctions during the pendency of opposer's motion for summary judgment

[16] To the extent that opposer seeks entry of Rule 11 sanctions on this basis, opposer's motion is essentially frivolous. However, because opposer's motion for Rule 11 sanctions as it relates to the filing of applicant's motion for discovery sanctions sets forth a minimally plausible basis therefor, we decline to order opposer to show cause why sanctions under Fed. R. Civ. P. 11(c) should not be entered against opposer for filing a frivolous motion for entry of Rule 11 sanctions. See TBMP Section 527.02.

when the only available discovery-related motion available to it at the time was pursuant to Fed. R. Civ. P. 56(f) and for making misrepresentations of law and fact therein which it contends are intended to prejudice the Board. Although applicant's motion for discovery sanctions was not germane to the motion for summary judgment, we find that its filing and the allegations raised therein do not warrant entry of sanctions herein.

As such, opposer's motion for Rule 11 sanctions is hereby denied. In the interest of avoiding unnecessary delay herein, each party is hereby prohibited from serving on its adversary, for safe harbor purposes, or filing with the Board, any further motions for Rule 11 sanctions without first outlining the basis for any such motion in a telephone conference with the interlocutory attorney assigned to this case.

Proceedings herein are resumed. Discovery and trial dates are reset as follows.

DISCOVERY PERIOD TO CLOSE:	**6/11/04**
Plaintiff's thirty-day testimony period to close:	**9/9/04**
Defendant's thirty-day testimony period to close:	**11/8/04**
Plaintiff's fifteen-day rebuttal period to close	**12/23/04**

[17] Applicant's amendments to allege use and the filing fee submitted in connection therewith will be returned to applicant in due course.

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Central Mfg. Co.

v.

Paramount Parks, Inc.

Opposition No. **91123765**

PROVISIONS FOR PROTECTING CONFIDENTIALITY OF INFORMATION REVEALED DURING BOARD PROCEEDING

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, **or** the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract.[18] The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

[18] There may be a remedy at court for any breach of contract that occurs after the conclusion of this Board proceeding. *See* Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552, 1555 (TTAB 1987). *See also*, Alltrade Inc. v. Uniweld Products Inc., 20 USPQ2d 1698 (9th Cir. 1991).

TERMS OF ORDER

1) **Classes of Protected Information.**
The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential—Material to be shielded by the Board from public access.

Highly Confidential—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) **Information Not to Be Designated as Protected.**
Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) **Access to Protected Information.**
The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters,

stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.

- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.

- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.

- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their **attorneys** shall have access to information designated as **confidential** or **highly confidential**, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as **trade secret/commercially sensitive**.

Independent experts or consultants, **non-party witnesses**, and **any other individual** not otherwise specifically covered by the terms of this order may be afforded access to **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) **Disclosure to Any Individual.**
Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected

information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) **Disclosure to Independent Experts or Consultants.**
In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) **Responses to Written Discovery.**
Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) **Production of Documents.**
If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1.

Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) **Depositions.**
Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) **Filing Notices of Reliance.**
When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) **Briefs.**
When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) **Handling of Protected Information.**
Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Order of the Board, effective March 8, 2004.

/apb/
Andrew P. Baxley
Interlocutory Attorney